

REMARKS

A. Claims

Claims 72-74, 77, 79, 89, and 96 were amended. Claims 75-76 and 80-81 were cancelled. Claims 97-100 were added. Claims 72-74, 77-79, and 82-100 are pending.

B. 35 U.S.C. §102 Rejections

The Office Action rejected claims 72-77, 80-81, and 86-96 under 35 U.S.C. 102(b) as being anticipated by Gallagher et al. (U.S. Patent No. 5,971,804) (hereinafter “Gallagher”). Applicant respectfully disagrees with these rejections.

Applicant respectfully reminds the Examiner that the standard for “anticipation” is one of fairly strict identity. To anticipate a claim of a patent, a single prior source must contain all the claimed essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q.81, 91 (Fed.Cir. 1986); *In re Donahue*, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed.Cir. 1985).

Gallagher does not appear to disclose, teach, or suggest at least “wherein the midplane rear face is operable to abut the at least one power supply, switch, or service processor when the at least one power supply, switch, or service processor is received in the carrier enclosure” or “wherein the midplane front face is operable to abut the rear edge face of the blade enclosure when the server blade is received into the carrier enclosure” as recited in amended claim 72. Gallagher teaches a backplane 30 for a vertical arrangement of modules. Gallagher does not appear to disclose a midplane. Applicant respectfully asserts claim 72 and claims dependent thereon are allowable for at least the above reasons. Applicant respectfully requests the Examiner withdraw the rejections to the claim 72 and claims dependent thereon.

C. 35 U.S.C. §103 Rejections

The Examiner has rejected claims 79 and 82-85 under 35 U.S.C. § 103(a) as being unpatentable over Gallagher in view of Derrico et al. (U.S. Patent Application No. 2002/0078290) (hereinafter “Derrico”). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima*

facie case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

The Office Action has not stated a *prima facie* case of obviousness for combining Gallagher and Derrico. As stated in the MPEP §2142:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no teaching or suggestion to combine Gallagher and Derrico either in the references or in the prior art. Furthermore, Applicant respectfully notes that Gallagher teaches away from Derrico. For example, Gallagher teaches the use of a backplane with the components in the Gallagher chassis generally stacked vertically. Derrico teaches a horizontal arrangement. Further, while the Examiner points to connector 254a of Gallagher, the Examiner only notes "figure 1" of Derrico (but does not identify any specific elements of Derrico). Therefore, while the rejection is thus unclear, Applicant respectfully submits it would not have been obvious to put the figure 1 elements of Derrico onto the backplane 30 of Gallagher (which includes the connector 254a).

The showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant respectfully reminds the Examiner, as stated in MPEP §2141: "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention (emphasis added)." The mere fact that references can be combined or modified does